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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,522	07/26/2001	Jin-Kwan Kim	06192.0248.NPUS00	6306

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McGuireWoods LLP  
1750 Tysons Boulevard  
Suite 1800  
McLean, VA 22102

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/912,522

Applicant(s)

KIM ET AL.

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4 and 7-10 is/are rejected.
- 7) ☐ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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This is in response to application filed on July 26, 2001 in which claims 1-10 are presented for examination.

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it is not clear as to which "converted IP information" is being transmitted in part (c) of claim 1. Also, it is not clear as to which "converted IP information" is being stored or transmitted in part (e) of the claim 1. Applicant is required to amend the claim to clearly define the steps of the method claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Snyder et al. U.S. Patent no. 6,038,561.

As per claim 1, Snyder et al. disclose "a method for analyzing and utilizing intellectual property information" by providing a system for analyzing patent texts, such as patent claims, abstracts and other portions of a patent document (See Snyder et al. Abstract). In particular, Snyder et al. disclose the claimed limitations of "registering search strategy formulas for extracting intellectual property information" by providing input search set (item 10 of figure 1B) which is a text format file of patents to be searched (See Snyder et al. Col. 11, lines 5-7); "accessing and searching internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search" through a query processing that manipulates the input data 10 to yield a searchable dataset (See Snyder et al. Figure 9B; Col. 11, lines 7-20). In addition, Snyder et al. disclose the claimed limitations of converting the first IP and second IP information to a standard form and storing the first IP information or converted IP information and transmitting the converted IP information to the research center PCs (See Snyder et al. Col. 13, lines 12-56). Further Snyder et al. disclose

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accessing the Internet websites and extracting second IP information corresponding to the first IP information (See Snyder et al. Col. 25, line 60-Col. 26, line 21).

As per claim 4, Snyder et al. disclose “an intellectual property IP information extraction unit for extracting IP information according to operation of software form at least one on-line IP information DB found on the Internet or on a network” as a Netscape Browser interface (See Snyder et al. Figure 9A). In particular, Snyder et al. disclose the claimed feature of “an IP information analyzing unit (See Snyder et al. Col. 25, line 40-Col. 26, line 31). Further an E-mail receiving/transmitting unit is inherent in the Netscape Browser. Especially, the Netscape Browser includes a “Send page” feature that allows E-mail to be received or transmitted.

As per claims 7-8, the aspect of the extraction of IP information has been addressed in the rejection of claim 1 above. Therefore, claims 7-8 are rejected as set forth above.

As per claim 9, the aspect of the “IP information analyzing” unit has been addressed in the rejection of claim 4 above. Therefore, claim 9 is rejected as set forth above.

As per claim 10, the aspect of the E-mail receiving/transmitting unit has been addressed in the rejection of claim 4 above. Therefore, claim 10 is rejected as set forth above.

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***Allowable Subject Matter***

6. Claims 2-3 and 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record failed to teach the aspect of IP information that includes technical analyses and technical classifications.

***Conclusion***

**Any response to this action should be mailed to:**

Commissioner of Patents and trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 305-9051, (for formal communications  
intended for entry)

**Or:**

(703) 308-5357 (for informal of draft  
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.**

**II. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703)**

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**308-14367. The Fax phone number for this Group is (703) 746-7238;  
(703) 746-7239; (703) 746-7240.**

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**

*Technology Center 2171*  
July 24, 2003